

### **REMARKS**

Claims 1-3 are currently pending in this application. Claims 4-63 were withdrawn without traverse. Claims 1 and 3 have been amended for minor linguistic corrections. No new matter has been added. Applicants reserve the right to pursue original and other claims in this and other applications.

Claims 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshida et al. (U.S. 5,257,131) in view of Yokota (U.S. 5,656,565). For the following reasons, Applicants respectfully traverse these rejections.

Yoshida teaches a “polarization detector having a polarization diffraction element used for optical pickups.” (Yoshida, Col. 1, lines 7-9.) “The polarization diffraction element 1 is placed obliquely to the light source . . . so that the incident light 5 falls upon the diffraction grating 3 at an incident angle  $\theta$ .” (Yoshida, Col. 8, lines 64-69.) Yokota teaches “an optical pickup device designed to be capable of detecting a tilt error caused by warping et cetera of a recording medium without providing a separate tilt sensor.” (Yokota, Col. 2, lines 53-60.)

Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness for claim 1, because the alleged references are not properly combinable. Without the benefit of impermissible hindsight, there would have been no motivation to combine Yokota and Yoshida.

The Supreme Court recently said in KSR Int'l Co. v. Teleflex Inc. that “the [Graham] factors continue to define the inquiry that controls” a finding of obviousness and reiterated that a “patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” 127 S. Ct. 1727, 1734 (U.S. 2007). The Graham factors include determining the scope and content of the prior art, ascertaining differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art. Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966). “Patent examiners carry the

responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case.” M.P.E.P. § 2141.

The Office admits that Yoshida does not teach or disclose a tilt sensor at all. (Office Action at 2.) Instead, to allegedly show that Yoshida and Yokoda may be properly combined and that the Applicant’s claims are obvious in light of these references, the Office merely states that “to use the pickup as a tilt sensor” would have been “obvious at the time of the invention to one of ordinary skill in the art” because “[o]ne of ordinary skill in the art at the time of the applicant [sic] invention would have used the optical pickup as a tilt sensor to apply a known technique to a known pickup device ready for improvement, to yield predictable results.” (Office Action at pages 2-3.)

Applicants respectfully traverse this assertion. To begin with, Applicants submit that the Office’s assertion is not a proper substitute for applying the Graham factors. The Office has not applied the proper test for obviousness; accordingly, the Office Action fails to make a *prima facie* case of obviousness.

Further, the Office has done no more than cite a pair of references, each of which allegedly provides only part of the claimed invention, and from these separate references thereby allege that their combination renders the invention obvious. Applicants submit, however, that without the benefit of hindsight, there would have been no motivation to combine these references.

To the contrary, several elements of Yokota teach away from combining it with Yoshida. The Office concedes that Yoshida fails to disclose a tilt sensor at all. (Office Action at page 2.) In order to combine the two references, the Office asserts that Yokota is “in the same field of endeavor” as Yoshida. (Office Action at page 2.) Yet Yokota is in the field of “an optical pickup device used in . . . an optical video disk device,” (Yokota, Col. 1, lines 7-9), while Yoshida relates to “a polarization detector . . . for optical pickups and the like,” (Yoshida, Col. 1, lines 7-9).

Despite this disparity, the Office asserts that, in view of Yokota, “it would have been obvious . . . to use the pickup [of Yoshida] as a tilt sensor.” (Office Action at page 2.) Applicants

submit that this assertion completely misconstrues the teachings of Yokota. Yokota teaches “an optical pickup device designed to be capable of detecting a tilt error . . . without providing a separate tilt sensor.” (Yokota, Col. 2, lines 53-57.) Yokota does not suggest using an optical pickup as a tilt sensor, as would be required to combine the two cited references.

Furthermore, on the one hand, Yokota teaches a diffraction element that is perpendicular to the non-diffracted light beam. (See, e.g., Yokota, FIG. 1.) In Yoshida, on the other hand, the polarization detection is accomplished by placing the diffraction element “obliquely to the light source . . . so that the incident light falls upon the diffraction grating at an incident angle  $\theta$ .” (Yoshida, Col. 8, lines 64-69.)

Moreover, even if the references were properly combinable, Applicants respectfully submit that the references would not render claim 1 obvious. In order to establish a prima facie case of obviousness “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. §2142. Neither Yoshida nor Yokota, even when considered in combination, teaches or suggests all of the limitations of claim 1.

Applicants respectfully submit that Yoshida does not disclose, teach, or suggest “a diffraction element disposed at a position on an optical path of a light beam from the object, the position determined in accordance with a positional relation with the object, wherein the diffraction element diffracts diffraction light at a diffraction efficiency depending on an incident angle of the light beam” as recited in claim 1. The Office cites FIG. 6 generally, as well as a portion of the specification detailing the Bragg angles of reflection, as constituting a diffraction element with “the position determined in accordance with a positional relation with the object.” (Office Action at page 2.) To the contrary, the cited portion of Yoshida does not teach that the diffraction element is positioned “in accordance with a positional relation with” any object, and FIG. 6 of Yoshida contains no objects other than the diffraction element itself. Nor is Yokota cited for these limitations. Thus, Yokota does not remedy the deficiencies of Yoshida.

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Claims 2 and 3 depend from claim 1, and are patentable over Yoshida in view of Yokota for at least the reasons stated above. Accordingly, Applicants respectfully request that the 35 U.S.C. § 103(a) rejections of claims 1-3 be withdrawn, and the claims be allowed.

In view of the above, Applicants believe the pending application is in condition for allowance.

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Respectfully submitted,

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